

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

Submitted herewith are certified copies of Japanese Patent Application Nos. 2002-283416 and 2002-286110, filed September 27, 2002 and September 30, 2002, respectively, to which the present application claims the benefit of foreign priority. The Examiner is respectfully requested to acknowledge receipt of such documents.

By the above amendments, claim 6 has been canceled without prejudice or disclaimer. Claim 1 has been amended to incorporate the subject matter of claim 6. Claim 1 has also been amended for clarification purposes to recite discharging an oil based ink composition from an inkjet recording device. Support for this amendment can be found at least at page 1, lines 4-8 of the specification. Claim 1 has further been amended for clarification purposes to recite that the oil based ink composition comprises fine particles dispersed in a non-aqueous dispersion medium, wherein the fine particles are obtained by melting and kneading a coloring agent and a binder resin to provide a colored mixture and subjecting the colored mixture to wet dispersion, wherein each fine particle comprises the coloring agent and the binder resin, and wherein the coloring agent is coated with the binder resin. Support for such amendment can be found in the specification at least from page 46, line 19 to page 48, line 1, taken in connection with pages 68-69 (Example 2).

Claims 2-5 have been amended to be directed to methods, in light of the above amendment of claim 1. Claim 4 has been amended for readability purposes to recite standard Markush group language. New dependent claim 7 recites that the oil based ink composition

has a viscosity of from 1.0 to 40 cp at 25°C. Support for this new claim can be found in the specification at least at page 54, lines 2-5.

In the Official Action, claim 4 stands rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth at page 2 of the Official Action. As discussed above, claim 4 has been amended to recite standard Markush group language, in accordance with the Examiner's suggestion. Accordingly, withdrawal of the §112, second paragraph, rejection is respectfully requested.

Claims 1, 2 and 4-6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0058729 (*Oshima et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 1 is directed to a method of forming an image by an inkjet recording system using an oil based ink composition, comprising discharging an oil based ink composition from an inkjet recording device, wherein the oil based ink composition comprises fine particles dispersed in a non-aqueous dispersion medium, wherein the fine particles are obtained by melting and kneading a coloring agent and a binder resin to provide a colored mixture and subjecting the colored mixture to wet dispersion, wherein each fine particle comprises the coloring agent and the binder resin, and wherein the coloring agent is coated with the binder resin, and wherein the binder resin comprises a block copolymer having a repeating unit (a) corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms or a graft copolymer having the repeating unit (a) in the main chain thereof.

Oshima et al does not disclose each feature recited in claim 1, and as such fails to constitute an anticipation of such claim. For example, *Oshima et al* does not disclose an oil based ink composition that comprises fine particles obtained by melting and kneading a

coloring agent and a binder resin to provide a colored mixture, and subjecting the colored mixture to wet dispersion, as recited in claim 1. Applicants respectfully submit that the claimed fine particles, which are formed from a different process than that disclosed by *Oshima et al*, are in fact distinct from the particles disclosed by *Oshima et al*. Accordingly, withdrawal of the above §102(b) rejection is respectfully requested.

Claims 1 and 3-6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,254,425 (*Suzuki et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Suzuki et al does not disclose each feature recited in claim 1, and as such fails to constitute an anticipation of such claim. For example, *Suzuki et al* does not disclose a method of forming an image by an inkjet recording system using an oil based ink composition, comprising discharging an oil based ink composition from an inkjet recording device, as recited in claim 1. In this regard, *Suzuki et al* discloses the use of "a colorant which is composed of a resin and a pigment or dye and which is used in preparing a liquid developing agent for electrostatic photography, a printing ink, an ink for an ink-jet system and a coating paint composition, as well as to use of the colorant as a component in a liquid developing agent, a toner supply and a toner kit for electrostatic photography" (col. 1, lines 8-15). However, *Suzuki et al* has no disclosure of a method of forming an image which comprises discharging an oil based ink composition from an inkjet recording device, as recited in claim 1.

In addition, as discussed above, newly presented claim 7 is directed to an additional aspect of the invention, and recites that the oil based ink composition has a viscosity of from 1.0 to 40 cp at 25°C. *Suzuki et al* fails to disclose such viscosity range recited in claim 7.

For at least the above reasons, withdrawal of the §102(b) rejection is respectfully requested.

Claims 1, 2, 4 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,302,537 (*Kato*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Kato does not disclose each feature recited in claim 1, and as such fails to constitute an anticipation of such claim. For example, *Kato* does not disclose an oil based ink composition that comprises fine particles obtained by melting and kneading a coloring agent and a binder resin to provide a colored mixture and subjecting the colored mixture to wet dispersion, as recited in claim 1. In stark contrast, *Kato* discloses resin particles that are obtained by polymerization granulation (col. 3, lines 35-36). Applicants respectfully submit that the claimed fine particles, which are formed from a different process than that disclosed by *Kato*, are distinct from the particles disclosed by *Kato*. Accordingly, withdrawal of the above §102(b) rejection is respectfully requested.

Claims 1, 4 and 6 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0128349 (*Qian et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Qian et al does not disclose each feature recited in claim 1, and as such fails to constitute an anticipation of such claim. For example, *Qian et al* does not disclose an oil based ink composition that comprises fine particles obtained by melting and kneading a coloring agent and a binder resin to provide a colored mixture and subjecting the colored mixture to wet dispersion, as recited in claim 1. Moreover, Applicants respectfully submit that the claimed fine particles, which are formed from a different process than that disclosed

by *Qian et al*, are distinct from such particles disclosed by *Qian et al*. Accordingly, withdrawal of the above §102(e) rejection is respectfully requested.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being obvious *Kato* in view of *Suzuki et al*. This rejection is moot in light of the incorporation of the subject matter of claim 6 which has not been rejected in the above rejection, into claim 1. Accordingly, for at least this reason, withdrawal of the rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL PC (INCLUDING ATTORNEYS
FROM BURNS, DOANE, SWECKER & MATHIS)

Date: January 3, 2006

By: 

Roger M. Lee

Registration No. 46,317

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620